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GROUP 3600

Docket No.: YPO-103  
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:  
Akira SUGIYAMA

Appeal No.: 2003-2050

Confirmation No: 2741

Application No.: 09/194,051

Art Unit: 3621

Filed: March 25, 1999

Examiner: C. L. Hewitt

For: UNIQUE TIME GENERATING DEVICE AND  
AUTHENTICATING DEVICE USING THE  
SAME

SUPPLEMENTAL REPLY BRIEF

MS Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under Rule 193 in response to the Supplemental Examiner's Answer mailed on June 2, 2004.

It is noted that "[t]he primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief." M.P.E.P. §1208.03.

A Remand To Examiner of March 25, 2004 (Paper No. 30) has been rendered by the Board of Patent Appeals and Interferences (the Board) stating that the application is premature for review by the Board. The Board remanded the application to Examiner to let him file Supplemental Answer that explains how one claim of this application is obvious over U.S. Patent No. 5,933,625 in view of U.S. Patent No. 5,502,765, or, alternatively, reopen prosecution.

In this regard, the Supplemental Examiner's Answer fails to overcome the points raised within Appeal Brief and the Reply Brief, at least for the following reasons.

"A double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent" (emphasis added). M.P.E.P. §804 III.

Within the Supplemental Examiner's Answer, the Examiner has selected claim 1 of the above-identified application for comparison with claims 1-7 of U.S. Patent No. 5,933,625 issued to Sugiyama (the '625 patent) and U.S. Patent No. 5,502,765 issued Ishiguro et al. (the '765 patent).

In this regard, it is initially noted that the '765 patent is to an inventive entity other than that for the above-identified application. Although the Supplemental Examiner's Answer refers to the presence of the '765 patent in maintaining the rejection of the claims for the above-identified application, please note that this analysis is to be made within the context of a double-patenting rejection, and not an obviousness-type rejection under 35 U.S.C. §103.

Claim 1 is drawn to an authentication-data issuing system based on unique time, said authentication-data issuing system including a plurality of computers connected with each other via communication lines with one of said computers set to function as a master computer, said master computer comprising:

a unique time generating device including time keeping means for sequentially outputting unit time values at predetermined intervals over a preset time-measuring period that begins at a given start point on a selected date and terminates at a given future end point and accumulating means for sequentially accumulating said unit time values output by said time keeping means so as to constantly measure a changing elapsed time within the time-measuring period;

transmitter means for, during communication between said master computer and another of the computers subservient to said master computer, transmitting, from said master computer to the subservient computer, authentication data based on an elapsed

time measurement, corresponding to a given time point, indicated by said unique time generating device; and

register means for receiving and registering an issuance history of unique authentication data created and issued by said subservient computer imparting additional data, unique to said subservient computer, to the authentication data transmitted by said master computer.

The Supplemental Reply Brief contends that the claimed unique time generating device is found within the claims of the '625 patent.

Claim 1 of the '625 patent and the claims dependent thereon arguably teach accumulating means for counting a number of timer signals outputted by said timer means within a preset time-measuring period that begins at a given starting point on a selected date and terminates at a given future ending point.

Claim 5 of the '625 patent and the claims dependent thereon arguably teach accumulating means for counting a number of timer signals outputted by said timer means within a preset time-measuring period that begins at a given starting point on a selected date and terminates at a given future ending point.

Nevertheless, the Supplemental Reply Brief fails to show within either the claims of the '625 patent or the '765 patent where there is found *the constant measurement of a changing elapsed time within the time-measuring period* as is found within claim 1 of the above-identified application. Thus, the Supplemental Reply Brief fails to show within either the claims of the '625 patent or within the '765 patent where there is found the claim 1 feature of *accumulating means for sequentially accumulating said unit time values output by said time keeping means so as to constantly measure a changing elapsed time within the time-measuring period.*

The Supplemental Examiner's Answer attempts to associate the features found within claims 5 and 7 of the '625 patent with the *transmission of authentication data based on an elapsed time measurement* found within claim 1 of the above-identified application. Yet, the Supplemental Reply Brief fails to show that the claims the *transmission of authentication data*

*based on an elapsed time measurement* found within claim 1 of the above-identified application and the features found within claims 5 and 7 of the '625 patent are indeed one and the same. This point is especially highlighted by the notation within the Supplemental Examiner's Answer that "the '625 patent claims do not specifically recite 'transmission means'".

The Supplemental Examiner's Answer contends that the '765 patent provides for the transmission means.

In response to this contention, the '765 patent arguably teaches that an IC card has a card information memory area wherein there are written a master public key nA, card secret keys pU and qU, a card public key nU, a card identification number IDU, and a first master digital signature SA1 for information including the card identification number (the 765 patent at Abstract, figure 4).

In this regard, the '765 patent fails to disclose, teach or suggest teaches the master public key nA, card secret keys pU and qU, the card public key nU, the card identification number IDU, or the first master digital signature SA1 being authentication data that is based on an elapsed time measurement.

The Supplemental Examiner's Answer contends that the '765 patent teaches a management center 4 that generates a time stamp for authenticating a transaction between the IC card 6 and the IC card computer 2. Please note that this contention is a gross misreading of the features found within claim 1 of the above-identified application, which includes:

transmitter means for, during communication between said master computer and another of the computers subservient to said master computer, transmitting, *from said master computer to the subservient computer*, authentication data based on an elapsed time measurement, corresponding to a given time point, indicated by said unique time generating device.

The '765 patent arguably teaches pieces of information that are provided in advance from the management center 4 to the IC card dispenser 5 that include (1) Master public key nA for verifying the master digital signature of the management center 4; (2) Card secret keys pU

and qU for the IC card 6 to create its digital signature; (3) Card public key nU for verifying the digital signature of the IC card 6; (4) Card identification number IDU for identifying the IC card 6; and (5) Master digital signature SA(nU\*IDU) of the management center 4 for the card public key nU and the card identification number IDU (the '765 patent at column 6, line 63 to column 7, line 9). Nevertheless, the '765 patent fails to disclose, teach or suggest these pieces of information being authentication data based on an elapsed time measurement.

The Supplemental Examiner's Answer cites figure 5 of the '765 patent and its associated description for feature of transmitting, from said master computer to the subservient computer found within claim 1 of the above-identified application. But please note that a review of figure 5 reveals that a master computer is not found within figure 5. Instead, figure 5 merely depicts an IC card terminal 2 and an IC card 6, whereby an authentication information (OK) representing it is sent to the IC card terminal 2 (the '765 patent at figure 5, column 9, lines 20-22).

The Supplemental Examiner's Answer cites figure 10 of the '765 patent and its associated description for feature of transmitting, from said master computer to the subservient computer found within claim 1 of the above-identified application. Figure 10 of the '765 patent is a modified form of the figure 5 embodiment that utilizes a time stamp (the '765 patent at column 5, lines 17-18). The '765 patent arguably teaches that "initial value TS<sub>0</sub> of the time stamp TS<sub>i</sub> may be recorded in a memory area 2M<sub>4</sub> of the RAM in the telephone controller 14 after being received from the management center 4 via the communication network 3 when the IC card terminal 2 is installed" (the '765 patent at figure 10, column 15, lines 22-26). However, the '765 patent fails to disclose, teach or suggest authentication data based on an elapsed time measurement being sent from the management center 4 to the IC card terminal 2. Instead, initial value TS<sub>0</sub> of the time stamp TS<sub>i</sub>, and not authentication data based on an elapsed time measurement, is sent from management center 4 of the '765 patent to the IC card terminal 2.

The '765 patent arguably teaches that it is necessary to utilize, for updating the time stamp TS<sub>i</sub>, an algorithm which generates the succeeding time stamp TS<sub>i+1</sub> from the current time stamp TS<sub>i</sub> under an encryption algorithm E using an encrypting key K, as exemplified in figure 11, to thereby prevent the previous time stamp from generation (the '765 patent at column 15,

lines 60-65). But the '765 patent fails to disclose, teach or suggest authentication data based on an elapsed time measurement that is sent from management center 4 to the IC card terminal 2.

The Supplemental Examiner's Answer contends, without providing any supporting evidence that the term "register" means store and the term 'issue' is equivalent to send."

The Supplemental Examiner's Answer also fails to show where within the claims of the '625 patent there is found "*register means*." Thus, the Supplemental Reply Brief fails to show where within the claims of the '625 patent *register means for receiving and registering an issuance history of unique authentication data created and issued by said subservient computer imparting additional data, unique to said subservient computer, to the authentication data transmitted by said master computer*, as is found within claim 1 of the above-identified application.

Also note that *each of said computers counts timer signals within a time-measuring period having a unique starting point and a unique ending point* is found within claim 1 of the '625 patent, and that *each of said computers counts timer signals within a time-measuring period having the same starting point and ending point* is found within claim 5 of the '625 patent. However, the Supplemental Examiner's Answer fails to show that either of these features are found within claim 1 of the above-identified application.

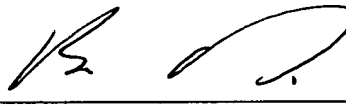
In addition, the record as a whole, including the Supplemental Examiner's Answer, fails to disclose, teach or suggest why the skilled artisan would have been motivated to modify the claims of the '625 patent with the features found within the '765 patent. Also note that since the '625 patent has a § 102(e) date of August 11, 1997 that is later than the March 25, 1997 filing date for the above-identified application, the Supplemental Examiner's answer fails to show that the requisite motivation to modify the claims of the '625 patent with the features found within the '765 patent would have existed at the time of the filing date of the above-identified application, especially in light of an non-existence of the application that matured into the '625 patent prior to the filing date for the above-identified application.

All other points have been addressed within the Appeal Brief and the Reply Brief, along with the arguments set forth therein are maintained.

The prior art of record fails to disclose, teach or suggest all the features of the claimed invention. For at least the reasons set forth hereinabove, the rejection of the claimed invention should not be sustained. Therefore, a reversal of the Final Rejection of January 17, 2002 is respectfully requested.

Dated: August 2, 2004

Respectfully submitted,

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